REMARKS

Prior to this amendment, claims 1-51 were pending in the present application. With this amendment, claims 4-5 have been amended. Consequently, the pending claims are 1-51. Reconsideration and allowance of the pending claims is respectfully requested.

Drawings

The Examiner has accepted the drawings as filed on October 1, 2003.

Rejection under 35 U.S.C. §112, second paragraph

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 have been amended for clarity making moot the Examiner's rejection under § 112. Specifically, claims 4 and 5 have been amended to replace "the at least one rack" with "the rack". Applicants request withdrawal of the Examiner's rejection of claims 4 and 5 under § 112 and allowance therefor.

Rejection under 35 U.S.C. §103(a)

A. Claims 1-6, 8-14, 16-22, 24-31, 32-34, 38-43, and 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matouk et al. (4691274) in view of Dubin (5971506). The Examiner states, in part:

> With respect to claims 1-6, 8-14, 16-22, 24-31, 32-34, 38-43, and 46-51, Matouk et al. teaches at least two modules (41, 42, 43) comprising at least one heat-generating component, each module (41, 42, 43) adapted to permit air to flow in the module such that airflow goes through, over, or adjacent to the at least one heat-generating component to cool the at least one heat-generating component (Emphasis added.)

Applicants respectfully traverse the Examiner's rejection. Claim 1 recites, in part:

> ...each computer comprising at least one heat-generating component, each computer adapted to permit air to flow in the computer such that airflow goes through, over, or adjacent to the at least one heat-generating component to cool the at least one heat-generating component; and
>
> a rack configured for the at least two computers to be placed in a back-to-back configuration such that the rack and computers will cooperate to direct air that flows through the computers (1) up to exit the rack through an upper section of the rack, (2) down to exit the rack through a lower section of the rack, or (3) both. (Emphasis added.)

In contrast, Matouk teaches, in part:

> A plurality of power modules are disposed in the framework and have heat sinks extending into the vertically disposed space, means for forcing air in a vertical direction through the space. (Col. 2, lines 35-39.)
>
> Cooling for the RTC module is accomplished by conduction from the exterior walls of the module into the room and also into the compartment 22 through which the air is passing. (Col. 4, lines 54-57; emphasis added.)

Contrary to the Examiner's assertions, Matouk does not teach that each module is "adapted to permit air to flow in the module such that airflow goes through, over, or adjacent to the at least one heat-generating component". As can be seen from the above-quoted passages, Matouk teaches that the cooling air flows vertically through the "vertically disposed space" and passes adjacent to the modules, cooling the modules by conduction through the exterior walls. The cooling air does not flow in or through the modules. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

In addition, Applicants traverse the Examiner's assertion that it would have been obvious to incorporate the computer of Dubin into the rack of Matouk et al. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987)).

The showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999). The initial burden is on the Examiner to establish not only that there is some suggestion of the desirability of doing what the inventor has done, but also that the combination itself is suggested, and further that the skilled artisan would have a reasonable expectation of success that the combination would result in the claimed invention. The Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

There is no teaching in either Matouk or Dubin for any modification of the type suggested in the Office Action. General conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. See *In re Thrift*, 298 F.3d 1357, at 1364 (Fed. Cir. 2002), *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Dembiczak*, 175 F.3d at 999.

Indeed, Matouk relates to a modular electronic power supply, not a computer rack. There is no suggestion or motivation for combining the references as proposed. In addition, the specification in Dubin suggests that the modification proposed by the Examiner would inhibit the

operability of the computer in Dubin. Specifically, Dubin states: "a back plate 141 containing openings 142 for connecting cords, an opening 144 for power and exit air, and an opening 148 for access to vertically mounted circuit boards." (Col. 2, lines 54-56.) If the computers in Dubin were positioned in a back-to-back orientation into the rack of Matouk, as proposed by the Examiner, the openings 142 in the back plate 141 would no longer be accessible, thereby inhibiting the connection of cords and access through the opening 148 to the vertically mounted circuit boards. Consequently, the proposed combination of references is unsupported and inappropriate. Applicants respectfully request that the Examiner withdraw the rejection of claim 1 and claims 2-8, which depend from claim 1.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness of independent claims 9, 17, 25, 33, 42, and 51. Applicants respectfully request allowance of these claims and claims 10-16, 18-24, 26-32, 34-41, and 43-50 which depend from claims 9, 17, 25, 33, 42, and 51.

B. Claims 7, 15, 23, 31, 35, 36, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matouk et al. (4691274) in view of Dubin (5971506) as applied to the claims above, and further in view of Wrycraft (6011689).

Wrycraft fails to cure the deficiencies described above with respect to Matouk and Dubin. Accordingly, the combination of Matouk, Dubin, and Wrycraft fails to establish a *prima facie* case of obviousness of claims 7, 15, 23, 31, 35, 36, 44, and 45, and Applicants request withdrawal of the rejection of those claims.

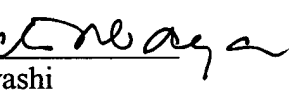
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 443452000103. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 17, 2004

Respectfully submitted,

By 

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